

**REMARKS/ARGUMENTS**

Claims 1-10 are pending in the subject application. Claims 1-9 are withdrawn pursuant to 37 C.F.R. § 1.142(b). Applicant hereinabove amended the Specification, amended claim 10, and cancelled withdrawn claims 1-9 without prejudice. Accordingly, upon entry of this Amendment, claim 10, as amended, will be pending and under examination.

Applicant maintains that the amendments to the Specification and to claim 10 do not raise any issue of new matter, and that such amendments are fully supported by the Specification as originally filed.

Support for the amendments to the Specification is found, *inter alia*, in the Specification as follows: pg. 14, ln. 15 to pg. 16, ln. 15; pg. 16, ln. 16 to pg. 17, ln. 22; pg. 17, ln. 23 to pg. 18, ln. 19; pg. 19, ln. 23 to pg. 21, ln. 2.

Support for the claim amendments is found, *inter alia*, in the Specification as follows: pg. 23, ln. 19 to pg. 24, ln. 5; pg. 28, lns. 21-22.

Moreover, in making these amendments, applicant neither concedes the correctness of the Examiner's objections or rejections in the March 17, 2008 Non-Final Office Action, nor abandons the right to pursue in a continuing application embodiments of the instant invention no longer claimed in this application.

In view of the remarks/arguments set forth below, and amendments to the Specification and claims hereinabove, applicant submits that the Examiner's objections and rejections made in the March 17, 2008 Non-Final Office Action have been overcome and respectfully requests that the Examiner reconsider and withdraw these grounds of objections and rejections.

**Priority and March 27, 2008 Examiner's Interview**

The Examiner stated that the claims of the subject application receive the priority date of November 17, 2006, and that a certified English translation of PCT International Application No. PCT/JP05/01870 must be submitted in order for the Applicant to obtain the benefit of foreign priority under 35 U.S.C. § 119(a)-(d). In support of her position, the Examiner cited 37 C.F.R. §§ 41.154(b) and 41.202(e).

In response to the Examiner's priority position, Applicant respectfully disagrees with the Examiner's position concerning the priority date of the claims of the subject application, and maintains that the claims of the subject application (which is a § 371 national stage application of PCT International Application No. PCT/JP05/01870) has a priority date of February 2, 2004.

The Examiner incorrectly cites to 37 C.F.R. §§ 41.154(b) and 41.202(e) in support of her position. These Patent Rules only apply to "Practice Before the Board of Patent Appeals and Interferences," and not to the prosecution of patent applications before the U.S. Patent and Trademark Office. *See* 37 C.F.R. § 41.1; M.P.E.P. 2304.01(c) (entitled "Translation of Foreign Benefit Application – 2300 Interference Proceedings").

Further, applicant's undersigned attorney, Cindy Yang, Esq., had a March 27, 2008 telephonic interview with Examiner Gussow regarding, among other things, the Examiner's priority position set forth in the March 17, 2008 Non-Final Office Action. *See* March 31, 2008 Interview Summary issued by the U.S. Patent and Trademark Office. Applicant wishes to thank the Examiner for her time and considering during this Interview.

In light of the March 27, 2008 Examiner's Interview, and as memorialized in the March 31, 2008 Interview Summary, it is understood that the Examiner has withdrawn her

position concerning priority and concedes that the claims of the subject application have the priority date of February 2, 2004.

### **Information Disclosure Statement**

The Examiner stated that the listing of references in the Specification is not a proper information disclosure statement, and, as suggested in 37 C.F.R. § 1.98(b) and M.P.E.P 609.04(a), that unless references have been cited by the Examiner on form PTO-892, they have not been considered.

In response to the Examiner's statements set forth in this section, but without conceding to the correctness thereof, applicant concurrently submits a Supplemental Information Disclosure Statement, which includes PTO/SB08/A&B Forms, copies of the references listed on pages 24-27 of the Specification. The fee for filing the Supplemental Information Disclosure Statement is ONE-HUNDRED AND EIGHTY DOLLARS (\$180.00), and such fee will be paid concurrently by credit card via the U.S. Patent and Trademark Office's EFS.

### **Drawings and March 27, 2008 and April 4, 2008 Examiner's Interviews**

The Examiner objected to an August 1, 2006 Petition to Enter Color Drawings ("Petition") since there are no accompanying copies of a color drawing or figure with the Petition.

In response to the Examiner's above objection, during the March 27, 2008 telephonic interview, applicant's undersigned attorney, Cindy Yang, Esq., informed the Examiner that a March 14, 2008 Statement of Accuracy of Copy, which included a complete and accurate copy of the Petition and three (3) sets of Figure 4, was filed with the U.S. Patent and Trademark Office in connection with the subject application. On April 4, 2008,

Examiner contacted Applicant's undersigned attorney indicating that she located the March 14, 2008 Statement of Accuracy of Copy, which included a complete and accurate copy of the Petition and three (3) set of Figure 4, and, as a result, indicated that this objection is now moot.

### **Objections to the Specification**

The Examiner stated that the Specification is objected to because a separate description is necessary for each part (*i.e.*, A-D) of Figure Nos. 1, 2, 3 and 6.

In response to the Examiner's above objection, but without conceding to the correctness thereof, applicant notes that the Specification has been amended in accordance with the Examiner's recommendations.

Thus, in light of the arguments herein and the amendments to the Specification made hereinabove, this objection is obviated.

### **Claim Rejection Under 35 U.S.C. § 102(b) (Novelty)**

The Examiner rejected claim 10 under 35 U.S.C. § 102(b) as allegedly being anticipated by Wang et al. (Oncogene, 1997, Vol. 15, pages 143-157).

In response to the Examiner's rejection under Wang et al., but without conceding to the correctness thereof, applicant notes that claim 10 has been amended.

Applicant notes that Wang et al. does not expressly or inherently describe each and every element of claim 10, as amended. For example, amended claim 10 recites "transporting BRCA1 from a nucleus to cytoplasm" and "wherein the co-expression of BRCA1 and CDK2-cyclin E and/or CDK2-cyclin A transports BRCA1 from the nucleus to cytoplasm." Nowhere does Wang et al. describe either of these elements.

Hence, in light of the above arguments, applicant maintains that claim 10, as amended, satisfies the requirements of 35 U.S.C. § 102(b).

The Examiner also rejected claim 10 under 35 U.S.C. § 102(b) as allegedly being anticipated by Rao et al. (U.S. Patent No. 6,720,158).

In response to the Examiner's rejection under Rao et al., applicant respectfully disagrees.

According to 35 U.S.C. § 102(b), patents must occur "more than one year prior to the date of the application for patent in the United States" in order to bar a patent application under 35 U.S.C. § 102(b). Rao et al., which was published on April 13, 2004, is not a proper § 102(b) reference since its April 13, 2004 publication date is less than one year prior to the February 2, 2005 filing date of the subject application, and after the February 2, 2004 priority date of the subject application.

Thus, in light of the above, applicant requests the Examiner to withdraw this rejection under Rao et al.

The Examiner further rejected claim 10 under U.S.C. § 102(b) as allegedly being anticipated by Hayami et al. (Cancer Research, 2005. Vol. 65, pages 6-10).

In light of the March 27, 2008 Examiner's Interview, and as memorialized in the March 31, 2008 Interview Summary, it is understood that the Examiner concedes that the claims of the subject application have the priority date of February 2, 2004, and that the February 2, 2004 priority date renders the § 102(b) rejection over Hayami et al. as moot since the Hayami et al.'s January 1, 2005 publication date is less than one year prior to the February 2, 2005 filing date of the subject application, and after the February 2, 2004 priority date of the subject application.

Therefore, in view of the above arguments, applicant maintains that claim 10, as amended, satisfies the requirements of 35 U.S.C. § 102(b).

**Conclusion**

In light of all of the foregoing, it is respectfully submitted that this application is now in condition to be allowed and the issuance of a Notice of Allowance is respectfully solicited.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone her at the number provided below.

Dated: September 2, 2008

Respectfully submitted,

By 

Cindy Yang

Registration No.: 55,749

DICKSTEIN SHAPIRO LLP

1177 Avenue of the Americas

New York, New York 10036-2714

(212) 277-6500

Attorney for Applicant